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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,903	11/18/2003	Zo-Chun Jen	JENZ3014/EM	3979

23364 7590 10/13/2004

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EXAMINER

EDWARDS, NEWTON O

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 10/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,903

Applicant(s)

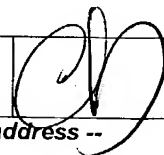
JEN, ZO-CHUN

Examiner

N Edwards

Art Unit

1774



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 1774

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected under 35 U.S.C 112 and 37 CFR 1.71 because it fails to provide an adequate written description of the invention and fails to provide an enabling disclosure.

The specification as filed fails to set forth 1) the type of molecular weight for component B polyalkylene glycol. See page 3-10 of spec. There is no guidance or direction of the type of molecular use to make the modified polyester filament of claim 1 in component B polyalkylene glycol. There are no working examples of the type of molecular weight use for the polyethylene glycol of claim 1. Thus, there would be an undue experimentation burden on the public to practice the invention as disclosed.

Claims 12-21 are rejected under 35 U.S.C. 112 first paragraph, for the reasons above in the objection.

Claims 12-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12, line 8" polyalkylene glycol having a *molecular weight* of from 10,000-30,000" is vague and indefinite as to the meaning of "molecular weight". What is the type of molecular weight?

Once again, to overcome the above rejections Applicant should file a CIP.

Art Unit: 1774

Applicant urges that 1) one must consider the level of skill in the art, but does not state a level.

The Examiner agrees and has considered this issue in making the rejection.

Application urges that 2) the standard of review for Enablement is *In re Wands*.

The Examiner is well aware of the standard of review and considered it when making the rejection.

Applicant concludes that 3) one of ordinary skill in the art would clearly appreciate that component B in the working examples deform PEG 20,000 is a molecular weight of 20,000.

The issue is the type of molecular weight (the meaning of molecular). One of ordinary skill in the art can not determine the meaning of molecular weight because there is no enablement, no written description, and no guidance or direction as to what molecular what means. There are no working examples as to the type of molecular weight used.

One of ordinary skill would not know whether it was number average molecular weight or weight average molecular weight. Thus there would be an undue experimentation on the public to practice the invention as disclosed. See Ex parte Simpson, 61 USPQ 2d 1009. The Examiner has identified the problem with this case and the solution to help applicant. *In re Simpson*, 61 USPQ 2d 1009.

Art Unit: 1774


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication should be directed to Primary Examiner Edwards at telephone number 571-272-1521.

N. Edwards/af

October 7, 2004



N. EDWARDS
PRIMARY EXAMINER